

REMARKS

Upon entry of the present amendment, claims 1 and 4 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. Claim 1 has simply been amended to incorporate limitations previously recited in claim 3 (now cancelled), and support for newly added claim 4 occurs in Figures 2-3 and pages 41-42 of the specification as originally filed.

Accordingly, entry of the present amendment is respectfully requested.

***Incorporation of Earlier Remarks***

On September 24, 2004 a response was filed in the matter of the instant application in response to the office action of June 28, 2004. Accordingly, the USPTO is respectfully requested to reconsider remarks set forth in the earlier response of September 24, 2004 as they remain relevant to a consideration of the patentability of the pending claims over the cited art being relied upon by the USPTO.

Accordingly the remarks set forth in the September 24, 2004 response at page 3, line 12 to page 5, last line, are incorporated herein by reference in their entirety. The Examiner is respectfully requested to reconsider the incorporated remarks at this time.

***Claim Rejections Under 35 USC § 103***

Claims 1-3 have been rejected under 35 USC § 103(a) as being unpatentable over Colton et al. (WO 89/00918), in view of Nishikawa et al. (US 5,997,781). Reconsideration and withdrawal of this rejection is respectfully requested based upon (i) the incorporated remarks from pages 3-5 of the prior response of September 24, 2004, and (ii) the following respectfully submitted remarks.

Although the USPTO may allege that it would have been obvious to one of ordinary skill in the art to use the Nishikawa et al. reference's specific amount of carbon dioxide in the Colton et al. molten resin, the instant Inventor submits that the USPTO's reasoning and understanding in making this asserted combination of references is both faulty and flawed.

Nishikawa et al. clearly mentions its object of providing a molded resin product, which contains cells having a uniform cell population (e.g., see column 1, lines 8-18, column 4, lines 5-14, columns 23-24 and Tables 1-4 of Nishikawa et al.), and discloses techniques based on its promise of providing a resin product that contains cells therein of a very small average cell diameter and a uniform cell population. (See columns 4-5 of Nishikawa et al.)

On the other hand, in the USPTO's Final Office Action it is specifically mentioned that Colton et al. shows a step of pressurizing the resin in the mold cavity to at least a pressure at

which the resin does not foam (see page 2 of the Office Action of June 28, 2004).

Accordingly, Colton et al. teaches away from the use of a resin of Nishikawa et al. that contains "cells of a very small average cell diameter and a uniform cell population" (e.g., see page 4, lines 5-10 of Nishikawa et al.).

As shown in the Examples of the present specification, no bubbles were found in the molded articles of the present invention. Consequently, there would have been no motivation to those of ordinary skill in the art to combine the teachings of Nishikawa et al. with those of Colton et al., as asserted by the USPTO, in a manner that would allow them to arrive at the instant invention as claimed. Absent such motivation in the teachings of the cited art the USPTO's outstanding rejection under 35 USC § 103(a) cannot be sustained.

As set forth in MPEP § 2141:

*Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966), stated:*

*Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be*

*utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy...*

Accordingly, after considering the above factors in the context of the instant case, and the fact that no motivation or teaching is provided in the cited art references that would allow one of ordinary skill in the art to arrive at the present invention as claimed, it follows that the outstanding rejection under 35 USC § 103(a) must be withdrawn at present.

#### CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1 and 4 are allowed and patentable under the provisions of Title 35 of the United States Code.

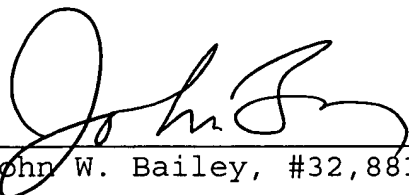
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By  \_\_\_\_\_  
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